

REMARKS

In the Office Action dated February 20, 2004, claims 1-3 stand rejected under 35 U.S.C. §112, first paragraph. Claims 1 and 2 also stand rejected under 35 U.S.C. §112, second paragraph.

As an initial matter, Applicants respectfully point out that claims 14-16 were added to the application in the amendment filed on October 9, 2003. However, the Office Action summary does not provide any acknowledgement of the entry and examination of these claims. Accordingly, an acknowledgement of the entry and examination of these claims is respectfully requested.

In response to the Office Action, Applicants have amended claim 1 and cancelled claims 2 and 15, which when considered with the remarks below are deemed to place the application in condition for allowance. Reconsideration of the application is respectfully requested.

Rejections Under 35 U.S.C. §112, Second Paragraph

Claims 1 and 2 stand rejected as being vague and indefinite. First, the Examiner contends that claims 1 and 2 appear to be identical. Second, claims 1 and 2 are deemed indefinite for using the article “a” with the noun “esters”. Finally, the Examiner points out that claim 2 recites “artificial tanning agents” twice.

In response, Applicants have cancelled claim 2 and 15 and amended claim 1. Claim 1 has been amended to replace “esters” with “ester” and to remove the redundant recitation of “artificial tanning agents.” Claim 2 has been cancelled since it appears redundant to claim 1. In addition, claim 15 has also been cancelled since it appears redundant to claim 14. Withdrawal of the rejections is respectfully requested.

Rejection Under 35 U.S.C. §112, First Paragraph

Claims 1-3 have been rejected for lack of enablement. The Examiner contends that “while the specification is enabling for crotonyl thiol esters synthesized by reaction of crotonyl thiol chloride to an alcohol which has been converted to a sulfhydryde or mercaptopropionate wherein the alcohol is a member of the Markush group recited in claim 1, does not reasonably provide enablement for any member of the Markush group in claim 1.” Office Action at page 2, first paragraph.

In response, Applicants respectfully submit that the Examiner lack of enablement rejection is misplaced. Applicants point out that all of the pending claims are product claims and not method claims. As the Examiner is well aware, Applicants does not need to show each and every possible reaction scheme for synthesizing (i.e., method of making) the compounds encompassed by these claims. Applicants respectfully point the Examiner’s attention to §2164.01(b) of the Manual of Patent Examining Procedure, which recites:

As long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement of 35 U.S.C. 112 is satisfied. *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970). Failure to disclose other methods by which the claimed invention may be made does not render a claim invalid under 35 U.S.C. 112. *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1533, 3 USPQ2d 1737, 1743 (Fed. Cir.), *cert. denied*, 484 U.S. 954 (1987).

Applicants’ specification clearly provides a method of making the claimed compounds as admitted by the Examiner in the Office Action. Pursuant to case law, only a single method of making is required. Thus, Applicants do not see the basis for this rejection.

In addition, Applicants submit that the Examiner has also not met the requisite burden of proof for issuing a lack of enablement rejection. The requisite burden of proof for a lack of

enablement rejection is clearly laid out in §2164.04 of the Manual of Patent Examining Procedure, which recites:

In order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure). A specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. Assuming that sufficient reason for such doubt exists, a rejection for failure to teach how to make and/or use will be proper on that basis. *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). As stated by the court, "it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure." 439 F.2d at 224, 169 USPQ at 370.

Applicants submit that no sufficient basis has been set forth to make a lack of enablement rejection. Merely not providing additional methods of making the claimed compounds, when one method of making has already been provided, does not meet the requisite burden of proof for issuing a lack of enablement rejection.

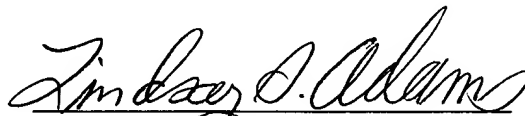
Applicants therefore submit that pending claims 1, 3, 14 and 16 are enabled. First, Applicants are only required to provide a single method of making the claimed compounds. Second, the requisite burden for issuing a lack of enablement has not been met since nothing in the Office Action questions the truth or accuracy of the specification. Withdrawal of the

rejection is respectfully requested.

In view of the above amendment and remarks, it is respectfully submitted that the present application is in condition for allowance. If the Examiner has any questions regarding the amendment submitted herewith, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number indicated below.

Applicants do not believe that any fees are due with this response. However, if any fees are due, please charge such sums to our Deposit Account 50-1145.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Lindsay S. Adams", written over a horizontal line.

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